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G. E. EHRLICH (1995) LTD.

No. 1512 P. 13/19

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Applicant:

Pinchas SHALEV et al.

Serial No.: 10/535,536

Filed: May 18, 2005

For: Electric Shaver With Heated Cutting
Element And With Deodorant Dispenser

Examiner: Stephen J. Ralis

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Group Art Unit: 3742

Attorney
Docket: 35746Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**NOTICE OF APPEAL AND PRE-APPEAL BRIEF**

Sir:

Applicants hereby appeal the Final Rejection of the Examiner dated January 2, 2008, rejecting claims 7, 9-11, 13-16 and 18-36.

This application enjoys Small Business Entity status.

Please charge the Notice of Appeal fee of \$255.00 to Deposit Account 50-1407.

A duplicate copy of this notice is enclosed.

Further, enclosed is a Pre-Appeal Brief in conformance with the "New Pre-Appeal Brief Conference Pilot Program" published on July 12, 2005 in the Official Gazette.

Concurrently with this paper Applicants are filing a response after final. In addition to the arguments for patentability made in this paper, Applicants are requesting in the response that the finality of the rejection be withdrawn and are arguing the propriety of the request for a terminal disclaimer. If finality is withdrawn the appeal will be moot.

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Respectfully submitted 255.00 DA

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Registration No. 33,877

Date: April 2, 2008

PRE-APPEAL BRIEF REQUEST FOR REVIEW

In the Final Office Action dated January 2, 2008, claims 7, 9-11, 13-16 and 18-36 were finally rejected.

Claim rejections - 35 U.S.C. §102

Claims 7, 10, 11, 13, 15 and 17 stand rejected under 35 U.S.C. §102(b) as anticipated by Kelman (WO Publication No. 92/16338). Applicants respectfully traverse the rejection and submit that the Examiner has not set out a *prima facie* anticipation with respect to at least claim 7 and certainly not with respect to claim 11 since Kelman fails to disclose at least one feature of each of these claims.

Claim 7 requires "a heated elongate element heated to a temperature sufficient to cut hair, mounted on the structure". According to the Examiner, the heated elongate element of claim 7 is shown in Kelman as laser beam 18 which is a physical element producing a physical effect onto the hair.

The Examiner's rejection (on page 3) reads:

"With respect to the limitation of a heated elongate element, Kelman discloses a laser beam (18) that is used to cut hair (Abstract). A laser beam is an elongate beam of light that is amplified by stimulated emission of radiation. Kelman further discloses the hair being vaporized or carbonized at the location of impingement of the laser beam (18) thereon (page 5, lines 18-24). To carbonize hair by a laser beam (18) would involve a burning/heating since the laser beam (18) light is not carbonizing by a chemical process or by fossilization."

Firstly, Applicants contend that even accepting that a laser beam is an *elongate element* (which applicants do not), it is not heated to any temperature. The concept of temperature is completely foreign to electromagnetic radiation which can transmit energy but which does not have any temperature characteristic.

This is connected with the fact that the laser beam is not an element and certainly not a physical element as contended by the Examiner, except in the context of wave-particle duality. But even if it is considered to comprise photons which carry energy, these photons are not elongate elements and do not have a temperature. If one is looking for some *physical* element in a laser beam it is anything but elongate. Even the various portions of the beam (considered as electromagnetic radiation) are not connected as such to form an elongate element.

Applicants note that, in general, an attempt by an applicant to claim a laser beam, *per se*, as an element in a claim results in a rejection under 35 U.S.C. §112.

There is no temperature related to a laser beam. Temperature is a measure of the hotness of an object measured on a definite scale. (Merriam Webster). There is no such scale for or or the concept of temperature for lasers or other electromagnetic energy. Even when temperature is used for colors, it is actually a reference to the color of light emitted by a heated body. It is never utilized for lasers, since they have a single wavelength.

Lasers are not hot or cold *per se*. Rather they produce electromagnetic energy that heats an object that absorbs it. The laser itself is not hot at all. Thus, laser beam 18 of Kelman is composed of electromagnetic radiation that raises the temperature of an object that absorbs it. The electromagnetic radiation is what provides the effect of cutting to the hair that absorbs energy from the laser beam. However, the beam itself is not hot. Since temperature is a characteristic of an element and not of its effect on other objects, under the Examiner's definition, the temperature of the laser beam would be zero when it is in vacuum (since it does not transfer any energy). Further, under this definition, the laser beam has a low temperature in air (since it does not heat the air to a temperature sufficient to cut hair) and has the claimed temperature only when it touches hair. Applicants submit that this could not be considered a characteristic of the heated elongate element (as claimed). In order for the element to meet the claim the temperature has to be that of the element, independent of whether it is actually cutting hair. It will have this temperature wherever it is measured. However, applicants reiterate that they believe that the Examiner's definition is incorrect and that an electromagnetic beam does not have a temperate, by any reasonable accepted definition.

Moreover, even if one would interpret a laser beam to be a hot element, the beam is not a *heated* element as recited in the claim, since a heated element can only be interpreted as an element which is present even when not heated. However, laser beam 18 of Kelman does not exist in what the Examiner would like to consider an unheated state. The very existence of the beam (the examiner's interpretation of elongate element) is predicated on the existence of the photons. Absent the photons, the "elongate element" does not exist. It is difficult to see how one can heat an element, which even according to the Examiner's definition, does not exist in unheated form.

Claim 11 includes a similar limitation. In addition, claim 11 is not *prima facie* anticipated for yet another reason. It contains the limitation of "collecting the hair cuttings from the skin of the user." In Kelman, the hair cuttings are never deposited on the skin of the user. Rather the collection is made entirely inside the housing. Thus, there

is no such act taught by Kelman. It is noted that the electrostatic collection of Kelman would in the position shown in Kelman, be unable to remove hair from the skin, after the hair is cut. In Kelman, the objective of hair collection is to keep the hair from being deposited on the skin or inside the space containing the laser beam.

The dependent claims, including those discussed below as being additionally lacking in *prima facie* unpatentability, are patentable at least by virtue of their patentable parent claims.

Claim Rejections – 35 U.S.C. §103

Claims 9 and 14 stand rejected under 35 U.S.C. §103(a) as being obvious over Kelman in view of Inderosa (US Patent No. 5,065,515). Applicants respectfully disagree and submit that the Examiner has not provided a *prima facie* case of obviousness since a combination of Kelman and Inderosa would not result in claims 9 and 14.

Kelman describes a hair cutting apparatus where the hair is cut by a laser beam. For this use, the Examiner contends that it would have been obvious to replace the beam of Kelman with the pre-heating element of Inderosa, since Inderosa teaches that pre-heating can be by a heated metallic element or a laser. However, there is no teaching of such functional equivalence in the context of heating the hair to a temperature high enough to destroy it. Kelman realized, as would any person of the art that utilizing the metallic heated element shown in Inderosa for cutting purpose would destroy the skin together with the hair.

In fact, the very wording of claims 9 and 14 distinguish over the element of Inderosa. The claims define the heated element as a "wire." There is no wire in Inderosa. The metallic element of Inderosa is a rather large element with a large heat capacity. It needs to have this large heat capacity so that it can transfer enough energy to the skin without cooling off. However, if such a structure were used to replace the laser of Kelman, and heated to a temperature as presently claimed, the skin would be burned. There is just no way to utilize the heated metallic element of Inderosa to cut hair. The most it can do is to pre-heat and soften the hair, which is why it is followed by a blade in Inderosa.

A person of ordinary skill in the art, reading Inderosa, would understand that in order to reach a relatively low heating of the hair, i.e. not high enough for it to be cut, laser or metallic element heating may be equivalents. However, when hair is to be cut by

the radiation or heat, the hair should reach a substantially higher temperature and the metallic element of Inderosa would not be suitable.

Thus, a combination of the references could at best result in a device where the hair is preheated by a metallic heated element and then cut by a laser beam. It is not clear why anyone would want to do this, but replacing the laser beam of Kelman by the metallic element of Inderosa, even with raising its temperature is not obvious since it would not work. Applicants submit that the combination of the references fails to disclose the feature of "a heated elongate element heated to a temperature sufficient to cut hair" in claim 9 and the similar feature in claim 14.

Claims 16 and 18-36 stand rejected under 35 U.S.C. §103(a) as obvious over Kelman in view of newly-cited Bermingham (US Patent No. 3,045,345). Applicants respectfully disagree and submit that the Examiner has not provided a *prima facie* case of obviousness since the combination of the references would not result in the claimed invention.

At least claims 19-22, 25-28, 31-34 and 36 contain features which are not *prima facie* taught by the references either alone or in combination.

What appears to be common to the rejections is that the Examiner combines Kelman and Bermingham in a way that the electrostatically charged element of Kelman is replaced with the electrostatically charged element of Bermingham. Applicants respectfully disagree with the combination and submit that if one would combine Kelman and Bermingham the combination would not replace the electrostatically charged element of Kelman but rather add the electrostatically charged element of Bermingham to the device of Kelman. Therefore, the combination would not result in the claimed inventions.

The electrostatically charged element of Kelman as referred to by the Examiner is adapted to collect cut hair from within the chamber through which the beam passes.

Bermingham describes an electrical shaver which develops a static electrical charge by friction to provide an attracting force for the hairs to be cut and tends to set them in an optimum cutting position, see col. 2, lines 36-40. Thus, the electrostatically charged element in Bermingham is moved along the skin before the hair is cut and is adapted to prepare the hair for cutting. Thus, if one would combine Kelman and Bermingham, the result would be Kelman's shaving device with the *addition* of an electrostatically charged element which is moved on the skin before the laser beam.

While such a feature might be useful in Kelman, it is clearly different from the rejected claims.

It is further noted that in Kelman, the collection of the hair is made entirely in the device and the hair cuttings are never deposited on the skin of the user. Therefore, there would be no use for an electrostatically charged element as recited in the claims.

Thus, the combination suggested by the Examiner would not result in the rejected claims. In addition, the Examiner has not referred to all the features of the rejected claims.

For example, claims 19, 21, 25, 27, 31, and 33 (and claims dependent on them) recite "the electrostatically charged element contacts the skin after the hair has been cut" or similar wording. The Examiner did not specifically relate to this limitation in his rejection, adding further to the lack of *prima facie* unpatentability. However, as stated above, the electrostatically charged element in Kelman does not contact the skin and the element in Bermingham contacts the skin before hair has been cut. Accordingly, the prior art fails to teach the elements of claims 19-22, 25-28, and 31-34.

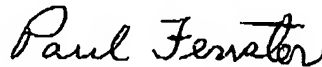
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Conclusion

Applicants believe that, for the reasons stated above, the final rejection of January 2, 2008 is not proper and without basis.

Applicants respectfully request that the Panel issue a Notice of Allowance in this case.

Respectfully submitted,



Paul Fenster

Registration No. 33,877

Date: April 2, 2008